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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/828,906

04/21/2004

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EXAMINER

FISHER, ABIGAIL L

ART UNIT

PAPER NUMBER

4173

MAIL DATE

DELIVERY MODE

10/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/828,906

Applicant(s)

ZHANG ET AL.

Examiner

Abigail Fisher

Art Unit

1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6 sheets</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-10 are pending.

Information Disclosure Statement

Only the English translated abstracts of WO 2006/018198 A1 and WO 02/49593 A2 were considered.

The inclusion of a copy of an International Search Report in the IDS has not been considered because these are non-published documents and can not be properly cited on a 1449 due to lack of a date of publication.

The information disclosure statement filed on April 21 2004, specifically document EP 1 222 916 A1, fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Election/Restrictions

The requirement for restriction set forth in the office action mailed on July 10 2007 has been withdrawn. A telephone call was placed to Applicant on September 26 2007 informing Applicant that the restriction was withdrawn and instead a species election between Group 1 (a terpenoid) and Group 2 (a fatty

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compound) was required. Applicant maintained election of a terpenoid and elected terpinene (α and γ).

The species election of cyclic terpenoids and hydrocarbons in the reply filed on August 8 2007 is acknowledged and maintained.

Claims 1-10 are pending in the application, with claims 3 and 9 having been withdrawn as drawn to a non-elected invention. Accordingly, claims 1-2, 4-8 and 10 are being examined on the merits herein.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is therefore deemed proper and is made FINAL.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

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be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2, 4-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodrigues et al. (US PG PUB No. 2002/0100122, published August 1 2002) in view of Nakatsu et al. (Patent No. 5965518, published October 12 1999).

Applicant Claims

Applicant claims a personal care composition, which they have defined in the specification to be lotions, creams as well as fabric-applied formulations (paragraph 00030). This composition comprises an unsaturated organic material, a substituted urea, and a cosmetically acceptable carrier. Useful carriers as defined by Applicant included water, saturated emollients and saturated fatty acids (paragraph 00019). One specific urea claimed is hydroxyethyl urea. Further limitations of the unsaturated material are that it contain at least two olefinic double bonds as well as those double bonds are in a conjugated relationship.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Rodrigues et al. describes dilute fabric softener formulations (example 23) that contain a hydroxyl compound and a perfume. Preferred hydroxyl urea compounds include N-2-hydroxyethyl urea (paragraph 0018), which reads on claim 2 of the instant application and meets the requirement of a substituted urea of claim 1. Water is included in formulation of the fabric softener thereby meeting the cosmetically acceptable carrier requirement of claim 1 of the instant application. Rodrigues et al. discloses that the hydroxyl compounds in the fabric softener composition are from 0.0001 to 20 percent (paragraph 0037), which reads on claim 5 of the instant application. The perfume included in the fabric softener (example 23) formulation of Rodrigues et al. is from 0.2 to 0.5 percent,

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which reads on claim 4 of the instant application. The ratio of substituted urea relative to the unsaturated material of example 23 of Rodrigues et al. reads on claim 6 of the instant application.

Nakatsu et al. describes fragrance compositions that have antimicrobial activity (abstract). These fragrance compositions comprise non-aromatic terpenoids (abstract). Nakatsu et al. discloses that the fragrances are made by selecting and combining various materials. These materials include non-aromatic terpenoid compounds of which various hydrocarbon cyclic terpenoids are listed including terpinene (column 3, lines 37-45). These terpenoids meet the requirement of the unsaturated organic material of claim 1 of the instant application. The various non-aromatic terpenoid compounds of Nakatsu et al. include terpinene and phellendrene. These are terpenoid compounds that contain at least two double bonds and those double bonds are in a conjugated relationship, which meet the requirements of claims 7 and 8 of the instant application. Nakatsu et al. discloses that the fragrance compound can be used in a fabric softener (claim 18).

***Ascertainment of the Difference Between Scope the Prior Art and the
Claims
(MPEP §2141.012)***

Rodrigues et al. does not describe what specific types of perfumes can be included in the compositions.

***Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)***

Thus, it would have been obvious to someone of ordinary skill in the art at the time of the instant invention to practice the invention of Rodrigues et al. using the fragrance composition of Nakatsu et al. One of ordinary skill in the art would be motivated to do this because the fabric softener of Rodrigues et al. contains water and therefore a fragrance composition that possesses antimicrobial activity would be advantageous. This would result in the practice of the instantly claimed invention with a reasonable expectation of success.

Regarding claim 10 of the instant application. Nakatsu et al. does not specify specific Iodine Values of the various terpenoid compounds. However the compounds of Nakatsu et al. are the same as those listed as hydrocarbon cyclic terpenoids in the instant application. Therefore there is a reasonable expectation that these compounds meet the required Iodine Value range as set forth in claim 10 of the instant application.

It is noted that In re Best (195 USPQ 430) and In re Fitzgerald (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail Fisher whose telephone number is 571-270-3502. The examiner can normally be reached on M-Th 9am-4pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718 or Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Abigail Fisher
Examiner
Art Unit 1609

Paul H. Landrum
Primary Examiner
All 1616